



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/233,475	01/20/1999	KUNIHICO WAKABAYASHI	017344-0290	7383

7590

06/06/2003

FOLEY & LARDNER
WASHINGTON HARBOR
3000 K STREET NW
SUITE 500
WASHINGTON, DC 200078696

EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 06/06/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/233,475

Applicant(s)

WAKABAYASHI, KUNIIHIKO

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,11,12 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11,12 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

1. The corrected or substitute drawings, Figure 4, were received on 6-11-02.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, 11, 12, 17-24 recite the limitation "voice response message" on lines 17, 18, 23, 24 in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 1 cites "voice reply message" on line 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2645

3. Claims 1, 2, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (US: 6052442), and in view of Inoue (JP 405227274A).

For claims 1, 2, 11 and 12, regarding “a memory.....from a sender”, Cooper et al teach on column 4 line 39 “incoming voice messages are digitized by A/D converter and stored in memory”.

Cooper et al failed to teach “the memory further.....the voice mail”. However, Inoue teaches on Abstract – an answering machine with a storage means (claimed “memory”) for recording both incoming and reply messages.

Regarding an identifier to identify a sender number attached to the voice mail that contains the digitized voice, the sender number corresponding to the sender that has sent the digitized voice, Cooper et al teach on column 2 line 59 “when the answering machine answers a call, before playing an outgoing message, it may read the telephone number of the calling party using the Calling Number Delivery (CND) service”. It is inherent that there must be an identifier of Cooper’s system to identify the sender number.

Regarding “an e-mail transmitter.....to the sender”, Cooper et al teach on column 7 line 47-51 a processor (claimed “e-mail transmitter”) packages the reply into the email format and transmits it to the sender of the original message.

Regarding a table that provides a correspondence between a plurality of e-mail addresses and a plurality of sender numbers, respectively; and a control unit.....apparatus, wherein the digitized voice is stored at a particular memory address that is assigned to the sender within the memory, based on the identification of the sender number as performed by the identifier, wherein the table is accessed to allow a recipient of the digitized voice to send an e-mail response to the

Art Unit: 2645

corresponding e-mail address of the sender, Cooper et al teach on item 10 Fig. 1 “processor” (claimed “control unit”). Cooper et al teach on column 9 line 40 “memory may include a pre-stored correspondence or ‘telephone directory’ between telephone numbers and.....other identifying information.....the user may also choose to automatically store email addresses of some or all senders into the telephone directory”. The “telephone directory” of Cooper et al is the claimed “table”. The “between telephone numbers and.....other identifying information.....the user may also choose to automatically store email addresses of some or all senders” reads on the claimed “correspondence between a plurality of e-mail addresses and a plurality of sender numbers”. Cooper et al also teach on column 9 line 34 “processor stores the (telephone) number in memory along with the message at the time it is received”. The “stores the (telephone) number in memory along with the message” of Cooper et al reads on the claimed “voice is stored at a particular memory address that is assigned to the sender within the memory based on the identification of the sender number”. Cooper et al also teach on column 11 line 26 “the user may select the destination address by using keypad to choose an entry in the telephone directory stored in memory”. The “using keypad to choose an entry in the telephone directory” of Cooper et al is the claimed “the table is accessed to allow a recipient...”. Cooper et al also teach on column 7 line 44 “the user may compose text for the reply using keypad”. The “text for the reply” of Cooper et al reads on the claimed “send an e-mail response”.

Regarding “the control unit obtains.....to the sender”, Cooper et al teach on column 7 line 47-51 a processor (claimed “control unit”) packages the reply into the email format and transmits it to the sender of the original message.

Art Unit: 2645

Regarding “the e-mail.....response message”, “Official Notice” is taken that opening an email and reviewing its attached voice response is old and well known to one skilled in the art. Also, although, Cooper et al did not teach how the original message sender opens an email and reviews its voice response attachment but Cooper et al did teach how the original message recipient opens an email and reviews its voice attachment (see column 2 line 1-7).

It would have been obvious to one skilled at the time the invention was made to modify Cooper et al to have the “the memory further.....the voice mail” and “the e-mail.....response message” as taught by Inoue such that the modified system of Cooper et al would be able to support the memory, and opening the mail with an voice response attachment to the system users.

4. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al and Inoue as stated in claim 1 above, and in view of Goldberg et al (US: 6304636).

Regarding claims 17, 19, 21, 23, Cooper et al and Inoue failed to teach “the at least.....to the sender”. However, Goldberg et al teach on column 3 line 26-28 the voice message is converted to be digitized text and included within the e-mail. It would have been obvious to one skilled at the time the invention was made to modify Cooper et al and Inoue to have the “the at least.....to the sender” as taught by Goldberg et al such that the modified system of Cooper et al and Inoue would be able to support the converting voice messages to be text to the system users.

Regarding claims 18, 20, 22, 24, Cooper et al and Inoue failed to teach “the sender.....a text file”. However, Goldberg et al teach on column 3 line 32-34 the voice message within the

Art Unit: 2645

email can be either listened to if it's an audio file or can be read if it's in a text format. It would have been obvious to one skilled at the time the invention was made to modify Cooper et al and Inoue to have the "the sender.....a text file" as taught by Goldberg et al such that the modified system of Cooper et al and Inoue would be able to support the listening or reading the audio message to the system users.

Response to Arguments

5. Applicant's arguments filed on 4/2/03 have been fully considered but they are not persuasive.

- i) Applicant requested, on page 7 of REMARKS, acknowledgement of drawing correction. The drawing, Figure 4, has been received on 6-11-02.
- ii) Applicant argues, on pages 8, regarding recipient responding an email with a voice attachment. However, rejections to this argument has been stated in claim 1 above.

Conclusion

Art Unit: 2645

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Application/Control Number: 09/233,475

Page 8

Art Unit: 2645

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a long horizontal stroke extending to the right.